

RESPONSE AND REMARKS

REJECTION UNDER SECTION 112 REJECTIONS

The Office Action rejected Claim 1 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Office Action, Topic No. 5, page 3. In rejecting Claim 1 under Section 112, the Office Action stated that the limitation “wherein the label height is less than the postage label height and wherein the label height is less than the postage label length,” ... is not found in the application’s specification as filed.

RESPONSIVE REMARKS REGARDING THE REJECTIONS UNDER SECTION 112

The rejections under Section 112 have been carefully considered. For the reasons given further below, it is respectfully submitted that the claimed limitation “wherein the label height is less than the postage label height and wherein the label height is less than the postage label length,” ... is fully supported by the application’s Specification as filed.

In particular, it is respectfully submitted that the Specification of the present application describes an exemplary embodiment, an exemplary illustration of which is depicted, for example, in FIG. 7A. The Specification describes an exemplary postage indicia label 14 depicted in FIG. 7A that “shares the same features as postage indicia label 14 described above with respect to the first exemplary embodiment and depicted in, e.g., FIG. 1.” Specification, p. 15, lines 9-10. The Specification describes exemplary postage indicia label 14 as having an exemplary height of approximately 1.75 inches and an exemplary width [i.e., a length] of approximately 1.25 inches. See Specification, p. 9, lines 12-14. The Specification further describes the exemplary embodiment depicted in FIG. 7A, describing an exemplary label 135 that is a one-dimensional barcode label with an exemplary height of approximately .3 inches, and an exemplary width [i.e., a length], of approximately 2.875 inches. See Specification, p. 15, lines 13-23. The Specification further describes the exemplary embodiment depicted in FIG. 7A, describing an exemplary label 136 that is a one-dimensional barcode label, also with an

exemplary height of approximately .3 inches, and an exemplary width [i.e., a length], of approximately 2.875 inches. See Specification, p. 15, line 24- p. 16, line 4.

It is respectfully submitted that the exemplary height of exemplary labels 135 and 136 depicted in FIG. 7A, comprising an exemplary height of approximately .3 inches, therefore comprise an exemplary .3 inch height that is less than the exemplary height of approximately 1.75 inches of exemplary postage indicia label 14 depicted in FIG. 7a, and that further comprise an exemplary .3 inch height that is less than the exemplary 1.25 inch width/length of exemplary postage indicia label 14 depicted in FIG. 7a.

It is respectfully submitted that other label arrangement set embodiments of exemplary barcode labels 135 and 136 and exemplary postage indicia labels 14 are depicted in, for example, FIGS. 8-11. See also, e.g., FIGS. 7B and 7C.

In view of the above support in the Specification and Figures of the present application, it is respectfully submitted that the claimed limitation "wherein the label height is less than the postage label height and wherein the label height is less than the postage label length," ... is fully supported by the application's Specification as filed.

REJECTION UNDER SECTION 103(a)

In the Office Action, Claims 1-3 were rejected under 35 U.S.C. §103(a) as being unpatentable over Block (U.S. Patent No. 6,010,156, "Block"), in view of Pickering (U.S. Patent No. 6,557,755). Office Action, Topic No. 8, pages 4-7.

In the Office Action, Claims 4-6, 13, 19-21 and 31 were rejected under 35 U.S.C. §103(a) as being unpatentable over Block in view of Reid et al. (U.S. Publ'n No. 2005/0195214, "Reid"), Topic No. 9, pages 8-16.

In the Office Action, Claim 7, 22, 29, 30, 32 and 33 under 35 U.S.C. §103(a) as being unpatentable over Block in view of Reid, further in view of Pickering. Office Action, Topic No. 10, pages 17-24.

RESPONSIVE REMARKS REGARDING THE REJECTIONS UNDER SECTION 103(a)

The rejections under Section 103(a) have been carefully considered. Claims 1-3, 7, 13 and 29 have been amended to more distinctly claim the claimed invention.

A Declaration Under Section 132 by JP Leon (the "Leon Decl'n") was previously filed in support of a previously-filed response to a previous Office Action. That Declaration is referred to herein and a courtesy copy (marked "COPY") is filed herewith.

For the reasons and authorities described further below, it is respectfully asserted that the pending Claims of the present application, as amended, are patentable over the cited references and are in condition for allowance.

NONE OF THE CITED REFERENCES DISCLOSE A SHEET OF LABEL SETS, EACH SET
COMPRISING A POSTAGE INDICIA LABEL AND TWO SEPARATE BARCODE LABELS, OR
METHODS FOR PRINTING SUCH LABELS, AS CLAIMED IN ONE WAY OR ANOTHER BY CLAIMS 1,
2, 7, 30, 32 AND 33, AND THE CLAIMS DEPENDENT ON THEM

It is respectfully asserted that none of the cited references disclose, anticipate, teach or suggest a sheet of computer printable self-adhesive labels sets such that each set consists of a postage indicia label and two separate barcode labels, or methods for printing postage indicia and two separate barcode labels on sheets of label sets, as claimed in one way or another by amended Claims 1, 2, 7, 30, 32 and 33 of the present application. For example, Claim 1 recites "[a] sheet comprising a plurality of like-arranged computer printer printable self-adhesive label sets for use with a computer postage system, each of said computer printer printable self-adhesive label sets consisting of:"

a first label on a layer of self-adhesive label stock, comprising a postage indicia label, wherein the postage indicia label is adapted to be printed with a printing consisting of postage indicia, the postage indicia label comprising a postage label height and a postage label length, wherein the postage label height is greater than the postage label length;

a second label on the layer of self-adhesive label stock, comprising a first one-dimensional barcode label, the first one-dimensional barcode label comprising a set of dimensions adapted for receiving a printing consisting of a first one-dimensional barcode representing a set of mailing identification information, the first one-dimensional barcode comprising a one-dimensional barcode length and a one-dimensional barcode height, the set of dimensions comprising a label length and a label height, the label length at least as long as the one-dimensional barcode length and the label height at least as high as the one-dimensional barcode height, wherein the label height is less than the postage label height, wherein the label height is less than the postage label length, wherein the label length is longer than the postage label length, and

wherein the label length is longer than the postage label height; and

a third label on the layer of self-adhesive label stock, comprising a second one-dimensional barcode label, the second one-dimensional barcode comprising the set of dimensions, and adapted for receiving a printing consisting of a second one-dimensional barcode representing a set of address information.

Claim 2 similarly recites “[a] sheet of computer printer printable self-adhesive label sets arranged on a top, self-adhesive layer of a sheet of self-adhesive label stock for use with a computer postage system, each computer printer printable self-adhesive label set consisting of:”

a first label disposed on the top self-adhesive layer of the sheet of self-adhesive label stock, the first label consisting of a postage indicia label, wherein the postage indicia label is adapted to receive printing consisting of postage indicia, the postage indicia label comprising a postage indicia label height and a postage indicia label length, the postage indicia height being greater than the postage indicia label length;

a second label disposed on the top self-adhesive layer of the sheet of self-adhesive label stock, the second label consisting of a first barcode label, wherein the first barcode label is adapted to receive printing consisting of a first one-dimensional barcode representing mailing identification information, the first barcode label comprising a label length and a label height, the one-dimensional barcode comprising a one-dimensional barcode length and a one-dimensional barcode height, the label length exceeding the one-dimensional barcode length and the label height exceeding the one-dimensional barcode height, the label height being less than the postage indicia label height, the label height being less than the postage indicia label length, the label length being greater than the postage indicia label height, and the label length being greater than the postage indicia label length; and

a third label disposed on the top self-adhesive layer of the sheet of self-adhesive label stock, the third label consisting of a second barcode label, wherein the second barcode label is adapted to receive printing consisting of a second barcode representing delivery address information, the second barcode label comprising the label height and the label length.

The Office Action concedes that Block does not expressly disclose the claimed dimensions of the claimed barcode labels (Office Action, Topic No. 8, p. 4, (referring to Claim 1)), but asserts that Block could accommodate a one dimensional barcode because “the label length is at least as long as the one-dimensional barcode length and the label height is at least as high as the one-dimensional barcode height.” Office Action, Topic No. 8, p. 4 (referring to Claim 1).

The Office Action further concedes that Block does not expressly disclose three separate labels (one for postage indicia, and two separate labels, each for one-dimensional barcodes), but cites Pickering as disclosing "... separate one-dimensional barcodes representing mailing identification information and address information. (Fig 1, col 1: lines 45-55)." Office Action, Topic No. 8, p. 5 (referring to Claim 1). The Office Action asserts that it would have been obvious for Block "... to dedicate separate labels for postage indicia, a one-dimensional barcode representing a set of address information and a one-dimensional barcode representing a set of mailing identification information. Office Action, Topic No. 8, p. 5 (referring to Claim 1). The Office Action asserts that it would have been obvious to do so, asserting that "Block provides specific motivation to do so by disclosing that additional labels within each field to be associated with a single item to be mailed may be added to accommodate a user's need." Office Action, Topic No. 8, p. 5 (referring to Claim 1).

It is not disputed that various references of record disclose printing a one-dimensional barcode. However, it is respectfully asserted that none of the cited references disclose or contemplate label sets comprising separate barcode labels, or methods for printing barcodes on separate barcode labels, as claimed in one way or another by Claims 1, 2, 7, 32 and 33 of the present application. Moreover, for the reasons given below, contrary to the assertion by the Office Action, it is respectfully asserted that Block does not provide the asserted motivation to dedicate separate labels for postage indicia and one-dimensional barcodes.

Block states that "[a]dditional labels within each field to be associated with a single item to be mailed may be added to accommodate a user's need. Each label within the field may also be customized and sized to accommodate the desired use" Block, col. 3, lines 17-22.

However, for the reasons given below, it is respectfully asserted that the above-quoted general statement in Block does not teach or suggest the limitations of, for example, Claims 1 and 2, in which a one-dimensional barcode label is claimed to comprise a set of dimensions adapted for receiving a printing "consisting" of a one-dimensional barcode. In particular, it is respectfully asserted that, as compared to the limitations of, for example, Claims 1 and 2, in which a one-dimensional barcode label is

claimed to comprise a set of dimensions adapted for receiving a printing “consisting” of a one-dimensional barcode, Block discloses a one-dimensional barcode (depicted as element 315 in Block’s FIG. 3A) that is printed on an address label (depicted as element 303 in Block’s FIG. 3A), along with, and in addition to, other information, namely, delivery postal address information (depicted as element 313 in Block’s FIG. 3A).

As compared to the limitations of, for example, Claims 1 and 2, in which a one-dimensional barcode label is claimed to comprise a set of dimensions adapted for receiving a printing “consisting” of a one-dimensional barcode, it is respectfully asserted that Block fails to disclose any dedication of a single label to receive printing, consisting exclusively of a one-dimensional barcode.

Moreover, for the reasons given further below, it is respectfully asserted that Block’s inclusion of a one-dimensional barcode on a label that includes other elements, such as the aforementioned delivery postal address information (depicted as element 313 in Block’s FIG. 3A), teaches away from a separate barcode label dedicated for receiving printing, consisting exclusively of a one-dimensional barcode, as claimed, for example, by Claims 1 and 2.

Further, as compared to the claimed limitations of Claims 1 and 2 for label sets that comprise a postage indicia label and one or more one-dimensional barcode labels dedicated for receiving printing consisting exclusively of a one-dimensional barcode, it is respectfully asserted that Block teaches a system that prints all elements for a mail piece on a single label arrangement set and teaches that all elements for a mail piece would be printed on a single label arrangement set. For example, it is respectfully asserted that the above-quoted statement by Block that “[a]dditional labels within each field to be associated with a single item to be mailed may be added to accommodate a user’s need ...” (Block, col. 3, lines 17-20) teaches printing all elements for a mail piece on a single label arrangement set. Further, it is respectfully asserted that Block’s FIGS. 3A and 3B, teach printing all elements for a mail piece on a single label arrangement set.

As compared to printing all elements for a mail piece on a single label arrangement set as disclosed in Block (see, e.g., Block, col. 4, lines 58-60), it is respectfully asserted that the present application discloses label arrangement sets, such

as those depicted, for example, in FIGS. 7A, 7B, 7C, and 8-16, that could be applied to a mail piece on which other elements for a mail piece, such as, for example, a delivery address, and in the case of, for example, FIGS. 7A, 7B, 7C and 8-10 of the present application, a return address, had been pre-printed on, or would otherwise be applied to, the mail piece. In particular, it is respectfully asserted that FIGS. 7A, 7B, 7C, and 8-11 provide a postage indicia label (shown in the aforementioned figures as element 14, or as a variation of element 14, such as, for example, 14-1), and two one-dimensional barcode labels (shown in the aforementioned figures as elements 135 and 136, or as variations of 135 and 136, such as, for example, 135-1 and 136-1). FIGS. 7A, and 8-10 of the present application show an optional return address label, shown as optional element 150.

As compared to a system that would be programmed to print all elements for a mail piece on a single label arrangement set, such as would be done in the case of Block (see, e.g., Block, col. 4, lines 58-60), it is respectfully asserted that the present application explains with respect to one alternative exemplary embodiment that:

In another exemplary embodiment of the present invention, a method is provided for printing postage indicia and mailing tracking information onto a label arrangement set on a single sheet of self-adhesive labels. In this method, a computer postage system is directed to print postage indicia on a first label of the label arrangement set wherein the first label of the label arrangement set is adapted to be printed with postage indicia. The computer postage system is further directed to print a first graphic symbology on a second label of the label arrangement set, wherein the first graphic symbology represents mailing tracking information and wherein the second label of the label arrangement set is adapted to be printed with at least one graphic symbology representing mailing tracking information.

Specification, p. 14, lines 9-19.

It is respectfully asserted that exemplary embodiments of the limitations of, for example, Claims 1 and 2, would be useful over the cited references, because exemplary embodiments of label arrangement sets such as claimed in, for example, Claims 1 and 2 could be applied to mail pieces on which destination address information, for example, had already been, or could separately be, applied. Further, such separate application of a destination address could be performed by a system that did not have the capability to produce postage indicia or one-dimensional barcodes,

allowing the generation of postage indicia and one-dimensional barcodes to be generated by an exemplary embodiment of the limitations claimed, for example, by Claims 1 and 2.

Yet further, it is respectfully asserted that Block's FIGS. 3A and 3B in combination with the specification of Block, teach that elements for a mail piece that would appear on the mail piece in close proximity to each other, would be printed on a single label. For example, Block discloses a one-dimensional barcode (depicted as element 315 in Block's FIG. 3A) being printed on an address label (depicted as element 303 in Block's FIG. 3A), along with, and in addition to, other information, namely, delivery postal address information (depicted as element 313 in Block's FIG. 3A) that would conventionally appear on a mail piece in close proximity to each other. Block explains that "FIG. 3A displays an exemplary embodiment of a single field (301) of labels for an item to be mailed prepared in accordance with the present invention. The field of labels is a unitary segment containing data relating to the item to be mailed" Block, col. 4, lines 58-60. Block explains that the labels in the field (i.e., a single label arrangement set) other than the recipient address label (depicted as element 303 in Block's FIG. 3A) and the postage indicia label (depicted as element 305 in Block's FIG. 3A), are optional.

It is respectfully asserted that Block's disclosure that the recipient address label and the postage indicia label are not optional teaches away from a label arrangement set, such as claimed, for example, by Claims 1 and 2, that does not include a recipient address label, but instead provides for separate one-dimensional barcode labels.

In view of the above-given reasons, it is respectfully asserted that Block does not disclose, and does not provide a teaching or motivation, for printing one-dimensional bar codes on labels that are dedicated for receiving printing (i.e., "consisting of") a one-dimensional bar code. Yet further, in view of the above-given reasons, it is respectfully asserted that Block does not disclose, and does not provide a teaching or motivation, for printing only a subset of elements to be applied to a mail piece, such as postage indicia and one-dimensional barcodes, but not a recipient address, on a label arrangement set.

It is therefore respectfully asserted that notwithstanding the above-quoted disclosure of Block regarding additional labels, Block does not anticipate, teach or suggest separate one-dimensional barcode labels dedicated for printing consisting of one-dimensional barcodes.

The Office Action cites Pickering as disclosing “separate one-dimensional barcodes … (Fig 1; col 1: lines 45-55).” Office Action, Topic No. 8, p. 5 (referring to Claim 1). However, it is respectfully asserted for the following reasons that the limitations recited by, for example, Claims 1 and 2, are patentably distinct from Pickering, even when that reference is considered in combination with Block.

In particular, it is respectfully submitted that although Pickering discloses printing two one-dimensional barcodes (depicted as elements 202 and 204 in Pickering’s FIG. 2), Pickering discloses doing so directly on an address block (designated as element 200 in Pickering’s FIG. 2) of a mail piece. See Pickering, col. 3, lines 37-38. Further, Pickering explains that “[s]uch an address block can either be printed on the outside of an envelope or on a mailpiece inserted in an envelope such that address block 200 is visible through a window in the envelope.” Pickering, col. 3, lines 38-42.

In view of the above-identified disclosures of Pickering, it is therefore respectfully asserted that Pickering does not disclose printing only a subset of elements to be applied to a mail piece, such as postage indicia and one-dimensional barcodes, but not a recipient address, on a label arrangement set.

Further, it is respectfully asserted that printable labels arranged on a sheet of self-adhesive label stock as claimed by Claims 1 and 2 are distinguished from information printed directly on a mail piece as disclosed by Pickering.

As further distinguished from the disclosure of Pickering of printing one-dimensional barcodes directly on a mail piece, the Claims of the present application recite, for example, label sets comprising two barcode labels, each adapted to receive printing consisting of a one-dimensional barcode. Claim 2, for example, claims two separate barcode labels, each adapted to receive printing consisting of a one-dimensional barcode representing, for example, mailing identification information or delivery address information, as the case may be. See also, e.g., Claim 7 (claiming “…

directing the computer postage system to print a first one-dimensional barcode representing mail piece tracking information ... on a first rectangular barcode label ...).

In view of the above-described features of Pickering, it is therefore respectfully asserted that combining the disclosure of Pickering for printing one dimensional barcodes on the same mail piece in close proximity with a recipient address, even when combined with Block's required, non-optional recipient address label, does not disclose, anticipate, teach or suggest a sheet of computer printable self-adhesive labels sets such that each set consists of a postage indicia label and two separate barcode labels, or methods for printing postage indicia and two separate barcode labels on sheets of label sets, as claimed in one way or another by amended Claims 1, 2, 7, 30, 32 and 33 of the present application.

Further, it is respectfully submitted that Reid does not disclose labels, but rather discloses "different style sheets that describe how each page of [a] photobook will appear." Reid, ¶ [0083].

Further still, it is respectfully asserted that the complete absence in the references of record, including Block, Pickering and Reid, of printing two different barcodes or graphic symbologies on two separate barcode labels of a label set as claimed in one way or another by Claims 1, 2, 7, 30, 32 and 33 of the present application is evidence that Block, Pickering and Reid, even when combined, do not support an assertion of obviousness of the subject limitations.

Moreover, it is respectfully asserted that self-adhesive label sets comprising a postage indicia label and two separate barcode labels, or separately printing a postage indicia label and barcodes on two separate barcode labels of a label set as claimed in one way or another by Claims 1, 2, 7, 30, 32 and 33 would be useful over the cited references because such separate postage indicia and barcode labels could be applied to envelopes on which delivery and/or return address information had been previously printed, or to envelopes with windows through which delivery and return address information is displayed, that is separately printed, such as, for example, by software enabled for accessing and printing address information but that does not have the capability to generate one-dimensional barcodes or to generate postage indicia, such as computer-based postage indicia.

For the above-given reasons, it is respectfully asserted that Claims 1, 2, 7, 30, 32 and 33 of the present application, and therefore the Claims dependent on them, namely, Claims 3, 21, and 22, are distinguished from and patentable over, the references of record. Accordingly, it is respectfully asserted that Claims 1-3, 7, 21-22, 30, and 32-33 are in condition for allowance.

NONE OF THE CITED REFERENCES DISCLOSE A SHEET OF A PLURALITY OF LABEL SETS
COMPRISING A POSTAGE INDICIA LABEL AND A SEPARATE LABEL DEDICATED FOR
RECEIVING A BARCODE, AS CLAIMED IN ONE WAY OR ANOTHER BY CLAIMS 4 AND 5

As distinguished from the cited references, for reasons similar to those described above with respect to, for example, Claims 1 and 2, it is respectfully asserted that none of the cited references disclose, anticipate, teach or suggest a sheet of printable label sets such that each set comprises a postage indicia label and at least one separate label that is dedicated ("consisting of") to receiving a printing of a single barcode as claimed in one way or another by, for example, Claims 4 and 5.

As compared to a sheet of printable label sets such that each set comprises a postage indicia label and at least one separate label that is dedicated ("consisting of") to receiving a printing of a single barcode as claimed in one way or another by, for example, Claims 4 and 5, it is respectfully submitted that none of the labels in Block are dedicated to ("consisting of") receiving printing of a one-dimensional barcode. Rather, it is respectfully submitted that each Block label that depicts a barcode, also depicts other types of information on the same label. See, e.g., FIG. 3A of Block (showing label 303 comprising address information 313 and a barcode 315; and showing label 305 comprising human-readable postage indicia 317 and two barcodes 321 and 319).

For reasons similar to the reasons previously given above with respect to, for example Claims 1 and 2, as compared to printing all elements for a mail piece on a single label arrangement set as disclosed in Block (see, e.g., Block, col. 4, lines 58-60), it is respectfully asserted that the present application discloses label arrangement sets, such as those depicted, for example, in FIGS. 12-18, that could be applied to a mail piece on which other elements for a mail piece, such as, for example, a delivery address, and a return address, had been pre-printed on, or would otherwise be applied

to, the mail piece. In particular, it is respectfully asserted that FIGS. 12-18 provide a postage indicia label (shown in the aforementioned figures as element 14, or as a variation of element 14, such as, for example, 14-1), and a single one-dimensional barcode label (shown in the aforementioned figures as element 136, or as variations of element 136, such as, for example, 136-1). FIGS. 12-18 of the present application show an optional return address label, shown as optional element 150, or as a variation of element 150, such as, for example, 150-1.

Further, similar to the reasons previously given above with respect to, for example Claims 1 and 2, it is respectfully asserted that Block does not disclose, and does not provide a teaching or motivation, for label sets, or printing of label sets, comprising one or more labels dedicated for receiving printing “consisting of” a one-dimensional bar code as claimed in one way or another by Claims 4 and 5. Yet further, similar to the reasons previously given above with respect to, for example Claims 1 and 2, it is respectfully asserted that Block does not disclose, and does not provide a teaching or motivation, for label sets, or printing of label sets, comprising labels adapted for receiving printing of only a subset of elements to be applied to, a mail piece, such as postage indicia and one-dimensional barcodes, but not a recipient address, as claimed in one way or another by, for example, Claims 4 and 5.

Further still, similar to the reasons previously given above with respect to, for example Claims 1 and 2, it is respectfully asserted that although Pickering discloses printing two one-dimensional barcodes (depicted as elements 202 and 204 in Pickering's FIG. 2), Pickering discloses doing so directly on an address block (designated as element 200 in Pickering's FIG. 2) of a mail piece (see Pickering, col. 3, lines 37-38; Pickering, col. 3, lines 38-42), and does not disclose printing only a subset of elements to be applied to a mail piece, such as postage indicia and a one-dimensional barcode, but not a recipient address, on a label arrangement set.

Further, it is respectfully asserted that printable labels arranged on a sheet of self-adhesive label stock as claimed by Claims 1 and 2 are distinguished from information printed directly on a mail piece as disclosed by Pickering.

Moreover, it is respectfully asserted that self-adhesive label sets comprising a postage indicia label and a separate barcode label, or separately printing a postage

indicia label and a barcode on a separate barcode labels of a label set as claimed in one way or another by Claims 4 and 5 would be useful over the cited references because such separate postage indicia and barcode labels could be applied to envelopes on which delivery and/or return address information had been previously printed, or to envelopes with windows through which delivery and return address information is displayed, that is separately printed, such as, for example, by software enabled for accessing and printing address information and, for example, one type of one-dimensional barcode, such as, for example, delivery address information, but that does not have the capability to generate a one-dimensional barcode for another type of information, such as for example, tracking information, or to generate postage indicia, such as computer-based postage indicia.

For the above-given reasons, and for the reasons previously given above with respect to, for example, Claims 1 and 2, it is therefore respectfully asserted that the limitations claimed by, for example, Claims 4 and 5, of a sheet of printable label sets such that each set comprises a postage indicia label and at least one separate label that is dedicated to receiving a printing of (consisting of) a single one-dimensional barcode, are distinguished from the references of record. Accordingly, it is respectfully asserted that Claims 4 and 5, and the Claims dependent on them, namely, Claims 6, 30, 31 and 32, are patentable over the references of record and are in condition for allowance.

NONE OF THE CITED REFERENCES DISCLOSE A SHEET OF A PLURALITY OF LABEL SETS

WHERE EACH LABEL SET COMPRISSES A COMBINATION OF A PORTRAIT-ORIENTED

LABEL ADAPTED FOR RECEIVING PORTRAIT-ORIENTED PRINTING OF POSTAGE INDICIA

AND ONE OR MORE LANDSCAPE-ORIENTED LABELS ADAPTED FOR RECEIVING

LANDSCAPE-ORIENTED PRINTING CONSISTING OF A ONE-DIMENSIONAL BARCODE, OR

METHODS FOR SO PRINTING SUCH LABELS

In rejecting Claims 4-6, 13, 19-21 and 31, the Office Action concedes that Block does not expressly disclose portrait orientation of some labels and landscape orientation of other labels. *E.g., Office Action*, Topic No. 9 ("Referring to claim 4"), p. 8.

However, the Office Action asserts that “Reid et al disclose printing on one sheet pictures in both portrait and landscape orientation.” *E.g., Office Action*, Topic No. 9 (“Referring to claim 4”), p. 8 (citing FIG. 8e and paragraphs [0084] and [0089] of *Reid*).

The Office Action further asserts that “... it would have been obvious ... for Block to combine the ability to print labels in both portrait and landscape orientation on the same sheet as disclosed by Reid ... since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same functions as it did separately, and one of ordinary skill would have recognized that the result of the combination were predictable.” *E.g., Office Action*, Topic No. 9 (“Referring to claim 4,” pgs. 8-9).

The Office Action’s rejections of Claims 4-6, 13, 19-21 and 31 have been carefully considered. Claim 13 has been further amended to more distinctly claim the claimed invention.

For the reasons described further below, it is respectfully asserted that none of the cited references, whether considered alone or in combination, disclose, anticipate, teach or suggest a sheet of a plurality of label sets where each set comprises a combination of a portrait oriented label adapted for receiving portrait-oriented printing of postage indicia and one or more landscape-oriented labels adapted for receiving landscape-oriented printing consisting of a one-dimensional barcode, or methods for so printing such labels, as claimed in one way or another by Claims 4-6, 13, 19-21 and 31, as amended.

“[W]hen evaluating the scope of a claim, every limitation in the claim must be considered.” *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, (United States Patent and Trademark Office; *Official Gazette* Notices for November 22, 2005), § II.C (citing *Diamond v. Diehr*, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981)).

Yet contrary to the mandate by the *Interim Guidelines* to consider every claimed limitation, it is respectfully submitted that the rejections of Claims 4-6, 13, 19-21 and 31 do not include an indication that the “consisting of” limitation was considered. See, e.g., *Office Action*, Topic No. 9 (“Referring to claim 4”), p. 8.

Further, for reasons similar to those previously given above with respect to, for example, Claims 1 and 2, it is respectfully asserted that Block does not disclose, and does not provide a teaching or motivation, for label sets, or printing of label sets, comprising one or more labels that are dedicated for receiving printing of (i.e., "consisting of") a one-dimensional bar code, as claimed in one way or another by, for example, Claims 4-6, 13, 19-21 and 31, as amended.

Yet further, similar to the reasons previously given above with respect to, for example Claims 1 and 2, it is respectfully asserted that Block does not disclose, and does not provide a teaching or motivation, for label sets, or printing of label sets, comprising labels adapted for receiving printing of only a subset of elements to be applied to a mail piece, such as postage indicia and one-dimensional barcodes, but not a recipient address, as claimed in one way or another by, for example, Claims 4-6; 13, 19-21 and 31, as amended.

Further still, for the reasons described further below, it is respectfully asserted that Reid, that discloses creating "an aesthetically pleasing photobook" (Reid, ¶ [0080]) is unrelated to, and is not properly combined with, Block, which involves postage labels. It is therefore respectfully asserted that the Office Action has failed to set forth a *prima facie* case of obviousness of Claims 4-6, 13, 19-21 and 31 as required for an obviousness rejection under MPEP §706.02(j) and MPEP §2143.

As described further below, as compared to printing a photobook style sheet in an aesthetically pleasing way, it is respectfully asserted that printing postage indicia and mailing barcodes as claimed by, for example, method Claims 7 and 13, requires substantial precision (e.g., "according to a set of postage indicia requirements" as claimed by Claims 7 and 13) so that the postage indicia and mailing barcodes are readable by standard postal service scanning equipment.

As compared to printing on a photobook style sheet in an aesthetically pleasing way, it is respectfully asserted that label arrangement sets as depicted in Block, similarly require substantial precision.

In a sheet of label sets as claimed, for example, by Claims 4 and 5, it is respectfully asserted that a plurality of precisely located labels are disposed on the top

printable self-adhesive layer. See, e.g., FIGS. 7B, 7C, and 18; see also, e.g., Specification, p. 12, line 29 – p. 13, line 10.

It is respectfully asserted that it is understood in the art that postage indicia and mailing barcodes must be printed according to strict formatting requirements in order to be scannable, or otherwise machine-readable, according to standards imposed by the relevant postal service. See Leon Decl'n, ¶ 7. It is respectfully asserted that postage indicia must be scannable, or otherwise machine-readable, according to standards imposed by the relevant postal service so that the relevant postal service can confirm the amount of paid postage and can determine whether the postage indicia is valid or fraudulent. See Leon Decl'n, ¶ 8. It is respectfully asserted that mailing barcodes must be scannable, or otherwise machine-readable, according to standards imposed by the relevant postal service, so that the postal service can properly route mail and accurately report tracking. See Leon Decl'n, ¶ 8.

It is respectfully asserted that in order to ensure that postage indicia and related mailing barcodes will be scannable, or otherwise machine-readable, according to standards imposed by the U.S. postal service, before any entity is allowed to implement a method for printing U.S. postage indicia and mailing barcodes, the United States Postal Service rigorously scrutinizes the proposed labels and related procedures. See Leon Decl'n, ¶ 9.

In order to properly format postage indicia and mailing barcodes for printing on separate labels of a particular label set, it is respectfully asserted that a computer system must be programmed to precisely format the postage indicia and the associated mailing barcodes and to precisely format the spatial relationship of the postage indicia and the associated mailing barcodes as compared to a sheet on which the postage indicia and mailing barcodes are to be printed. See Leon Decl'n, ¶ 10. It is respectfully asserted that such precision in formatting is required so that the postage indicia and associated mailing barcodes can be printed completely within the perimeters, such as perimeters that have been micro-perforated, of the respective separate labels. See Leon Decl'n, ¶ 11. It is respectfully asserted that such precision in formatting is further required so that the postage indicia and associated mailing barcodes, once printed, will

be scannable, or otherwise machine-readable, by standard equipment used by the relevant postal service. See Leon Decl'n, ¶ 12.

It is respectfully asserted that the aesthetic photographic formatting and printing disclosed in Reid does not require a high degree of precision in formatting because there is no pre-defined perimeter, such as a micro-perforated perimeter, for the resulting photograph printout, and because there is no stringent requirement that a resulting Reid image be scannable, or otherwise machine-readable. See Leon Decl'n, ¶ 13. Further, it is respectfully asserted that the aesthetic formatting and printing of photographs disclosed in Reid would be subject to potentially substantial distortion as compared to the precision required for formatting and printing of postage indicia and mailing barcodes. See Leon Decl'n, ¶ 13.

For the above-given reasons, it is respectfully asserted that Reid is improperly combined with Block.

Yet further, it is respectfully asserted that the Office Action fails to support its assertion of obviousness to combine the Reid reference with Block with a factual basis for the combination. The Office Action cites KSR (KSR Int'l v Teleflex, 127 S. Ct. 1727 (2007)), but fails to observe the holdings and teachings of KSR.

In KSR, the Supreme Court acknowledged that "... inventions in most, if not all, instances, rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." KSR, 127 S.Ct. at 1741. "[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." KSR, 127 S.Ct. at 1741. Accordingly, the KSR Court reiterated its caution against hindsight bias and *ex post* reasoning. KSR, 127 S.Ct. at 1742. Accord Ortho-McNeil Pharmaceutical, Inc. v. Mylan Laboratories, Inc., 2008 U.S. App. LEXIS 6786, *14-*15 (Fed. Cir. March 31, 2008) (explaining that "a flexible TSM [teaching, suggestion, or motivation] test remains the primary guarantor against a non-statutory hindsight analysis . . ." (citations omitted)).

Contrary to the holding in Ortho-McNeil, it is respectfully asserted that the Office Action fails to set forth a teaching, suggestion or motivation for combining Reid with Block.

Further, it is respectfully asserted that the holding in KSR does not condone an assertion of obviousness where, as here, some of the claimed elements (such as, the above-described limitation regarding a label adapted for printing *consisting of* a one-dimensional barcode) have not even been shown to be disclosed by the references of record. Rather, the Supreme Court in KSR emphatically cautioned that “rejections on obviousness grounds cannot be sustained by mere conclusory statements” KSR, 127 S.Ct. at 1741 (quoting with approval, In re Kahn, 441 F.3d 977, 988 (CA Fed. 2006)).

Yet further, in addition to the above-mentioned absence from Block of any disclosure or teaching of a separate label dedicated to receiving printing of a one-dimensional barcode, it is respectfully asserted that the Office Action misconstrues the language of Reid regarding a landscape-oriented image and a portrait-oriented image.

Reid describes its FIG. 8e as depicting “a page with one landscape image and one portrait image.” Reid, ¶ [0084]. However, a close inspection of Reid’s FIG. 8e shows a landscape-oriented page with two rectangles. Because Reid describes photographic albums, then it is respectfully asserted that each of the two rectangles depicted in Reid’s FIG. 8e represents a photographic image. It is respectfully asserted that Reid’s FIG. 8e is properly viewed as depicting both the left-most photographic image and the right-most photographic image, in an “aesthetic” manner, so that if the landscape-oriented page of the photo-album depicted in Reid’s FIG. 8e were viewed as shown in Reid’s FIG. 8e, the left-most photographic image and the right-most photographic image would both be upright – that is, you would not need to turn the photo-album page depicted in Reid’s FIG. 8e one way to view one of the two photographic images, and then turn the photo-album page depicted in Reid’s FIG. 8e another way to view the other of the two photographic images.

That is not the case with the limitations claimed by Claims 4-6, 13, 19-21 and 31. For example, Claim 4 is directed to a sheet of a plurality of computer printer printable self-adhesive label sets that each comprises, among other things:

a first label arranged in a portrait orientation with respect to the sheet, the first label comprising a postage indicia label, wherein the postage indicia label is adapted to be printed with postage indicia according to postage indicia requirements in portrait orientation with respect to the sheet; and

a second label arranged in a landscape orientation with respect to the sheet and with respect to the first label, the second label comprising a first one-dimensional barcode label, wherein the first one-dimensional barcode label is adapted to be printed with a printing consisting of a one-dimensional barcode according to one-dimensional barcode requirements in landscape orientation with respect to the sheet;

It is respectfully asserted that, for example, FIG. 17 depicts an exemplary embodiment of the limitations claimed, for example, by Claim 4. FIG. 17 depicts a sheet 1000 of label arrangement sets (e.g., 112"-1a, 112"-1b, etc.) where each label arrangement set comprises a postage indicia label 14 that is arranged in a portrait orientation with respect to the sheet 1000 and further comprises a barcode label 136 that is arranged in a landscape orientation with respect to the sheet.

It is respectfully asserted that in order to view postage indicia printed on a postage indicia label 14 depicted on sheet 1000 in FIG. 17 in an upright position, sheet 1000 would need to be viewed from the portrait orientation depicted in FIG. 17. However, in order to view a one-dimensional barcode printed on a barcode label 136 in an upright position, sheet 1000 would need to be viewed from a landscape position, that is, turned a quarter-turn (clockwise or counterclockwise, depending on the particular landscape orientation of the barcode), so that the entire sheet 1000 could be viewed in a landscape position.

In view of the above-described distinctions, and for the above-given reasons and under the above-cited authorities, it is therefore respectfully asserted that the cited references, even when considered together, fail to disclose the combination of limitations claimed by Claims 4-6, 13, 19-21 and 31, and therefore the Claims dependent on them, namely Claims 32-33, of the present application. Accordingly, it is respectfully asserted that Claims 4-6, 13, 19-21 and 31, and the Claims dependent on them, namely Claims 32-33, are therefore patentable over the references of record and are in condition for allowance.

CONCLUSION

For the foregoing reasons and authorities, it is respectfully asserted that the invention disclosed and claimed in the present application is not fairly taught by any of the cited references, taken either alone or in combination, and that the application is in condition for allowance. Accordingly, reconsideration and allowance of the application is respectfully requested.

Respectfully submitted,

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